

### **Remarks**

Applicants have carefully reviewed the Office Action mailed on July 14, 2008. Applicants respectfully traverse (and do not concede) all objections, rejections, adverse statements, and adverse assertions made by the Examiner. Please cancel claims 43-48 and 51-55 without prejudice. Claims 31-37, and 39 remain pending.

### **Claim Rejections Under 35 U.S.C. §103**

Claims 31, 32, 35-36, and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Greene et al. in U.S. Patent No. 6,485,501 in view of Bagaoisan et al. in U.S. Patent No. 6,152,909. Claim 31 recites that the distal end of the retrieval adapter is configured to radially expand and receive at least a portion of the vascular filter within the lumen during retrieval of the vascular filter from the vessel. The Examiner indicated that “it is inherent that the distal end will have to undergo some expansion in order to fit over and hook onto the proximal end of the filter, for example at 372 in Fig. 28”.

Is well established that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. §2112, citing *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993) (emphasis in original). The alleged inherent characteristic or result must be present in all instances. There are a number of instances where female portion 373 may be mated with male barb-type snap 372. For example, female portion 373 may be compressed, elongated, and/or otherwise deformed (without expanding) in order to accommodate snap 372. Other arrangements may also be present. Accordingly, Greene et al. cannot inherently teach or suggest the distal end of the capture sheath tip 375 is configured to radially expand.

Furthermore, even if female portion 373 did expand, female portion 373 is not disposed at the distal end of the capture sheath tip 375 and, instead, is set back proximally from the distal end. Therefore, even if female portion 373 was expandable Greene et al. still fails to teach or suggest that the distal end of the capture sheath tip 375 is configured to radially expand.

Based on the forgoing comments, Applicants respectfully submit that Greene et al. does not teach or suggest all the limitations of claim 31. Bagaoisan et al. fails to

overcome the defects of Greene et al. Consequently, Applicants respectfully submit claim 31 is patentable over the combination of Greene et al. and Bagaoisan et al., to the extent that such a combination is even possible. Because claims 32, 35-36, and 39 depend from claim 31, they are also patentable for the same reasons as claim 31 and because they add significant elements to distinguish them further from the art.

Claims 33 and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Greene et al. in view of Bagaoisan et al. as applied to claim 31 above and further in view of Ferrera in U.S. Patent No. 6,240,231. For the reasons set forth above, Applicants respectfully submit that claim 31 is patentable over the combination of Greene et al. and Bagaoisan et al. Ferrera fails to overcome the defects of the cited art. Consequently, Applicants respectfully submit that claim 31 is patentable over the combination of Greene et al., Bagaoisan et al., and Ferrera, to the extent that such a combination is even possible. Because claims 33 and 34 depend from claim 31, they are also patentable for the same reasons as claim 31 and because they add significant elements to distinguish them further from the art.

Claims 37, 43, 44, 47, 48, 51, 52, and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Greene et al. in view of Bagaoisan et al. as applied to claim 31 above and further in view of Ha et al. in U.S. Patent No. 6,159,195. Without conceding the merits of the rejection, please note that claims 43, 44, 47, 48, 51, 52, and 55 are now cancelled without prejudice, rendering the rejection moot. Applicants reserve the right to pursue these claims or claims of a similar scope in the future.

Regarding claim 37, for the reasons set forth above, Applicants respectfully submit that claim 31 is patentable over the combination of Greene et al. and Bagaoisan et al. Ha et al. fails to overcome the defects of the cited art. Consequently, Applicants respectfully submit that claim 31 is patentable over the combination of Greene et al., Bagaoisan et al., and Ha et al., to the extent that such a combination is even possible. Because claim 37 depends from claim 31, it is also patentable for the same reasons as claim 31 and because it adds significant elements to distinguish it further from the art.

Claims 45 and 46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Greene et al. in view of Bagaoisan et al. in view of Ha et al. as applied to claims 43 and 51 above and further in view of Ferrera. Without conceding the merits of the rejection,

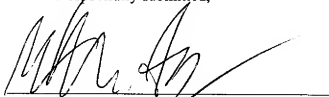
please note that claims 45 and 46 are now cancelled without prejudice, rendering the rejection moot. Applicants reserve the right to pursue these claims or claims of a similar scope in the future.

**Conclusion**

Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Date: Oct. 30, 2009

A handwritten signature in black ink, appearing to read 'Glenn M. Seager', is written over a horizontal line.

Glenn M. Seager, Reg. No. 36,926  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Tel: (612) 677-9050